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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,102	12/05/2003	Uwe Schein	WAS 0613 PUS / Wa 10265-S	3087
22045	7590	02/08/2005	EXAMINER	
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			PENG, KUO LIANG	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/729,102	Applicant(s) SCHEIM ET AL.	
	Examiner Kuo-Liang Peng	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/6/04 IDS.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/6/04, 1/29/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 3-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claims 1 (line 15), Claim 4 (line 5) and Claim 5 (line 4), it is not clear as to what “deactivator” (other than isocyanate) refers to. In the specification (page 8, lines 6-10), only isocyanates are cited. Furthermore, it is not clear as to what to be deactivated by the deactivator.

In Claim 11 (lines 2-3) and Claim 12 (lines 3-4), “crosslinkers having at least three organooxy radicals” causes confusion because not all organooxy radicals can participate in the crosslinking reaction of the present invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4 and 7-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Lucas (US 4 483 973).

For Claims 1-4 and 7-9, Lucas discloses a process for preparing an organopolysiloxane composition prepared by reaction of RTV composition components comprising a) a silanol-terminating polydiorganosiloxane of Formula 2), b) a scavenger of formula 3), c) a crosslinker of Formula 4), d) a catalyst, and e) a curing accelerator. (col. 9, lines 25-47, col. 10, line 9 to col. 11, line 14, col. 20, line 59 to col. 21, line 5 and Examples) The viscosity of component a) is described in col. 12, lines 3-29. An adhesion promoter such as amino-containing silanes, etc. can be used. (col. 14, line 50 to col. 20, line 52). The relative amount of the scavenger is described in col. 14, lines 28-49, col. 9, lines 34-37 and Examples. For Claims 10-12, a filler can be used. (col. 20, line 59 to col. 21, line 5 and Examples) For Claim 13, the composition is a RTV-1 composition. (col. 20, line

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59 to col. 21, line 5 and Examples) For Claims 14-15, Lucas further teaches a shaped body prepared by crosslinking the composition. (Examples)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4 and 7-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP167 (JP 63-083167) in view of Chung (US 4 495 331).

For Claims 1-2, 8-9 and 13, JP167 discloses a process for preparing an organopolysiloxane composition prepared by reaction of RTV composition components comprising A) a polyorganosiloxane end-capped with hydroxyl groups; B) α -aminomethyldialkoxysilane and C) a silicone compound containing three hydrolyzable groups. A plasticizer can be used. (page 2, upper right column to page 3, lower right column and page 4, upper right column and Examples) JP167 is silent on the use of a deactivator. However, it is well known that a

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scavenger is incorporated into a RTV composition. For example, Chung teaches the use of an isocyanate as a scavenger in the RTV composition containing a polyorganosiloxane end-capped with hydroxyl groups. The amount of the isocyanate is described in col. 2, lines 49-52 and Examples. The motivation is to afford a RTV composition with excellent stability. (col. 2, line 25 to col. 3, line 6). In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate Chung's isocyanate into JP167's RTV composition. Note that Chung's isocyanate reads on the isocyanate of the present invention. As such, Chung's isocyanate can obviously function as a "deactivator". Note that JP167 composition is a RTV-1 composition because it includes all ingredient in one pot. For Claim 3, the viscosity of component A) is described in page 2, upper right column and Examples. For Claims 4, 7 and 10, a catalyst can optionally be added. (page 3, lower right column to page 4, upper left column) For Claims 11-12, a filler can be used. (page 4, upper left column and Examples) For Claims 14-15, JP167 teaches a shaped body prepared by crosslinking the composition. (page 5, upper right column) The English translation of JP167 has been requested by Examiner. It will be available to Applicants later upon request.

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7. Claims 5-6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

None of Lucas, JP167 and Chung, taken alone or in combination, teaches or fairly suggests the process set forth in the instant claims.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->


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direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp

February 4, 2005

Kuo-Liang Peng
Primary Examiner
Art Unit 1712


KUO-LIANG PENG
PRIMARY EXAMINER